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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,681	05/22/2002	Kalevi Ratschunas	4925-219PUS	2735
7590	01/03/2006		EXAMINER	
Michael C Stuart Cohen Pontani Lieberman & Pavane 551 Fifth Avenue Suite 1210 New York, NY 10176			HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/089,681	RATSCHUNAS ET AL.
	Examiner	Art Unit
	Lisa Hashem	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 and 14-39 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 and 14-39 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 11-30-05.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. In response to the After Final Amendment filed on 11-30-2005, the Office Action mailed on 7-27-2005 is vacated because the Helferich reference is not considered prior art.

The response to the Amendment filed 4-22-2005 is a Non-Final Office Action and is set forth below. Please disregard the Office Action mailed on 7-27-2005.

### *Claim Objections*

2. Claim 21 recites the limitation "said group of users". There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 11, 12, 14-18, 23-26, 28-32, and 34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,119,014 by Alperovich et al, hereinafter Alperovich.

Regarding claim 1, Alperovich discloses a method for delivering messages in a network (Figs. 1-4) comprising at least one terminal device (Fig. 4: 400, 480), comprising: generating a message (e.g. SMS message; Fig. 4, 420) (col. 5, lines 27-30); setting a condition (e.g. priority indication, location information) for receiving said message (col. 4, lines 7-12; col. 5, lines 27-35);

deciding whether said message is to be received by a terminal device based on said condition (e.g. if terminal device is in location area corresponding to the location information then send the message); and

transmitting said message to said terminal device (Fig. 4, 400) based on deciding whether the message is to be received (e.g. whether the terminal device is in the location area) (col. 5, line 50 – col. 6, line 3).

Regarding claim 2, the method according to claim 1, wherein Alperovich further discloses said setting step is performed by a terminal device (Fig. 4, 480) (col. 5, lines 27-35).

Regarding claim 3, the method according to claim 1, wherein Alperovich further discloses said condition is a location of said terminal device (col. 5, lines 27 – col. 6, line 3).

Regarding claim 4, the method according to claim 1, wherein Alperovich further discloses including information regarding said condition in an optional field (Fig. 4, 470) of said message (col. 5, lines 27 – col. 6, line 3).

Regarding claim 5, the method according to claim 1, wherein Alperovich further discloses determining said terminal device (Fig. 2, 200) as being inactive or busy when said condition is inherently not met (col. 2, line 20 – col. 3, line 11).

Regarding claim 6, the method according to claim 1, wherein Alperovich further discloses deciding whether the originator of said message is permitted to receive a delivery report (e.g. failure report) (e.g. deciding whether the message was delivered); and transmitting said delivery report to the originator of said message only when said originator of said message is permitted the delivery report (e.g. when the message was not delivered) (col. 2, line 20 – col. 3, line 11).

Regarding claim 11, the method according to claim 1, wherein Alperovich further discloses said network is a mobile network (Figs. 1-4) and said terminal device is a mobile terminal device (Fig. 4: 400, 480) (col. 1, lines 25-45).

Regarding claim 12, Alperovich discloses a network system (Figs. 1-4) for delivering messages in a network, comprising:

a terminal device (Fig. 4, 400);

a message delivering device or SMS service center (Fig. 4, 460) comprising

a deciding means configured to decide whether a message is to be received by said terminal device based on a condition (e.g. priority indicator, location information) (col. 4, lines 7-12; col. 5, lines 27-35) for receiving said message (e.g. if terminal device is in location area

corresponding to the location information then send the message), and

a transmitting means configured to transmit said message to said terminal device based on said deciding means determining whether the message is to be received (e.g. whether the terminal device is in the location area) (col. 5, line 50 – col. 6, line 3).

Regarding claim 14, please see the rejection to claims 1 and 2 above, to reject the system in claim 14.

Regarding claims 15-18 and 23, please see the rejections of claims 3-6 and 11 above, respectively, to reject the system in claims 15-18.

Regarding claim 24, Alperovich discloses a report delivery condition setting device (Fig. 4, 480), comprising:

a setting means configured to set a condition (e.g. priority indication, location information) for receiving a message by a terminal device (Fig. 4, 400) (col. 4, lines 7-12; col. 5, lines 27-35); and

a supplying means configured to supply said message including said condition to a message delivering device (Fig. 4, 460) (col. 5, line 50 – col. 6, line 3).

Regarding claims 25, 26, and 28, please see the rejections of claims 3, 4, and 11 above, respectively, to reject the report delivery condition setting device in claims 25, 26, and 28.

Regarding claim 29, a message delivering device (Fig. 4, 480) configured to deliver in a network a message for which a condition (e.g. priority indication, location information) for receiving said message by a terminal device (Fig. 4, 400) is set, comprising:  
a deciding means configured to decide whether said message is to be received by said terminal device based on said condition (e.g. if terminal device is in location area corresponding to the location information then send the message) (col. 4, lines 7-12; col. 5, lines 27-35); and  
a transmitting means configured to transmit said message to said terminal device based on a result of said deciding means (col. 5, line 50 – col. 6, line 3).

Regarding claims 30-32 and 34, please see the rejections of claims 3-5 and 11 above, respectively, to reject the message delivering device in claims 30-32 and 34.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,014 by Alperovich, as applied to claims 1 and 12 above, respectively, in view of U.S. Patent No. 6,289,223 by Mukherjee et al, hereinafter Mukherjee.

Regarding claim 7, the method according to claim 6, wherein Alperovich does not disclose storing a list of originators of messages, which are permitted to receive delivery reports, in a database.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises steps of generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37).

Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted (col. 6, lines 21-30) and the step of storing a list of originators of messages in a database which are permitted to receive delivery reports (col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include storing a list of originators of messages, which are permitted to receive delivery reports, in a database as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission and wherein multiple originators can send a message to a terminal device and those originators are

recorded in a database to identify a valid sender of said received message who will receive a delivery report.

Regarding claim 8, the method according to claim 6, wherein Alperovich does not disclose:

defining a group of users which are allowed to receive delivery reports; wherein whether the originator of said received message is a member of said group of users is determined during said deciding step.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises: generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37).

Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted (col. 6, lines 21-30), storing a list of originators of messages in a database which are permitted to receive delivery reports (col. 6, lines 21-30), and defining a group of users which are allowed to receive delivery reports, wherein in said deciding step it is detected whether the originator of said received message is a member of said group of users (col. 3, line 46 – col. 4, line 37; col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include defining a group of users which are allowed to receive delivery reports; wherein whether the originator of said received message is a member of said group of users is determined during said deciding step as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission and wherein multiple originators can send a message to a terminal device and those originators are recorded in a database to identify a valid sender of said received message who will receive a delivery report.

Regarding claim 9, the method according to claim 8, wherein Mukherjee further discloses the step of adding a group identifier identifying said group of users to said message (col. 3, line 46 – col. 4, line 37).

Regarding claims 19-21, please see the rejections of claims 7-9 mentioned above, respectively, to reject the system in claims 19-21.

7. Claims 35-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich in view of Mukherjee.

Regarding claim 35, Alperovich discloses a terminal device (Fig. 4, 400) for receiving a message for which a condition (e.g. priority indicator, location information) for receiving said message is set for use in network (Figs. 1-4), comprising:  
a receiving means configured to receive said message (col. 5, line 50 – col. 6, line 3);  
a judging means configured to determine whether a delivery report (e.g. failure report) is to be transmitted in response to said message; and

a transmitting means configured to transmit said delivery report when said judging means determine that said delivery report is to be transmitted (col. 2, line 20 – col. 3, line 11).

Alperovich does not disclose a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises: generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37).

Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted and said message is received (col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission of said message.

Regarding claim 36, please see the rejections of claims 6 and 7, above, to reject the terminal device of claim 36.

Regarding claims 37 and 39, please see the rejections of claims 3 and 11 above, respectively, to reject the terminal device in claims 37 and 39.

8. Claims 10, 22, 27, 33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich, as applied to claims 1, 12, 24, 29, and 35 above, respectively, and in further view of U.S. Patent No. 6,732,273 by Byers.

Regarding claim 10, the method according to claim 1, wherein Alperovich further discloses said message is a SMS message (col. 2, lines 12-18).

Alperovich does not disclose said message is a multimedia message.

Byers discloses a method for delivering messages in a network (Fig. 1) comprising at least one terminal device (Fig. 1: 131, 134), comprising:  
generating a message (col. 3, lines 40-46);  
setting a condition (e.g. message characterizing code) for receiving said message (col. 3, line 46 – col. 4, line 20);  
deciding whether said message is to be received by a terminal device (Fig. 1, 131) based on said condition (e.g. determining a predetermined subscriber selected threshold based on the message characterizing code); and  
transmitting said message to said terminal device based on deciding whether the message is to be received (e.g. whether message meets certain predefined criteria) (col. 5, line 15 – col. 6, line 10).

Wherein Byers further discloses said message is a multimedia message (col. 2, lines 58-66).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include said message is a multimedia message as taught by Byers. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can send a multimedia message including: attachments, advertising, and audio/video clips to a terminal device.

Regarding claims 22, 27, 33, and 38, please see the rejection to claim 10 above, to reject claims 22, 27, 33, and 38.

*Response to Arguments*

9. Applicant's arguments, see Amendment, filed 4-22-2005, with respect to the rejection(s) of claim(s) 1-12 and 14-39 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections above.

10. Regarding Applicant's arguments that Alperovich fails to disclose the following limitations of claim 1: '...setting a condition for receiving a message, deciding whether the message is to be received by a terminal device based on the condition, and transmitting the message to the terminal device based on the result of the deciding step...' as cited on pages 10-11 of Applicant's response, the Examiner disagrees.

Examiner does agree that Alperovich teaches organizing SMS messages sent to a mobile terminal (Fig. 4, 400), however, Alperovich further discloses a condition for receiving a message (e.g. location information), wherein when the mobile terminal is in a position related to the

location information the originator (Fig. 4, 480) had set for the SMS message (Fig. 4, 420), the SMS service center (Fig. 4, 460) will deliver the message to the mobile terminal (col. 5, line 50 – col. 6, line 3). Further, Alperovich discloses controlling the transmission of message to a mobile terminal via the SMS service center and a specific message (Fig. 4, 420) is delivered to the mobile terminal based on location information (col. 5, line 50 – col. 6, line 3).

Thus, Alperovich clearly discloses the claimed invention.

11. Accordingly, this action is **NON-FINAL**.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,442,159 by Josse et al discloses routing a short message with high or low priority to a mobile station, wherein a choice is made in advance as to whether the short message should be received by the mobile station via a specific service

13. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

Art Unit: 2645

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

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December 23, 2005

*Gerald Gauthier*  
**GERALD GAUTHIER**  
**PATENT EXAMINER**